

REMARKS

In the Office Action mailed January 24, 2005 it was noted that Applicant did not include a specific election of one of the Inventions I-XIII set forth in the restriction requirement mailed on October 7, 2004, although a modified election was in fact made with traverse.

I. AN EXAMINER'S INTERVIEW WAS HELD ON APRIL 7, 2005:

A telephonic interview with the Examiner was held on April 7, 2005 in which Applicant argued that the restriction requirement in the Office Action mailed October 7, 2004 was too narrow for the reasons expressed herein and in Response A, and therefore the Examiner's Invention I should have included additional claims that were not part of Invention I. Applicant expresses appreciation to the Examiner for his clarifying remarks and assurance that Applicant's arguments contained in Response A and in this Addendum to Response A would be carefully and completely considered. The substance of the arguments presented during the interview is contained herein below.

II. SPECIFIC ELECTION OF CLAIMS:

In order to be responsive to the Office Action mailed January 24, 2005, Applicant hereby elects Invention I, with traverse, directed to claims 1-43, 92-108 as set forth in the Office Action mailed October 7, 2004. Applicant requests reconsideration of the restriction requirement for the purpose of obtaining agreement from

the Office to reduce the number of invention groupings from thirteen (13) inventions to four (4) inventions.

**III. SPECIFIC ERRORS IN THE RESTRICTION/ELECTION REQUIREMENT:**

Applicant submits that restriction of the present application into thirteen (13) different groups of claims is improper because there is commonality among dominant elements in many of the claims, such that there is no serious burden under M.P.E.P. § 803 for the Examiner to examine additional claims that should have been included together in Invention I of the Office's restriction requirement, as discussed below. Specifically, claims 1-43 and 75-184, as grouped by the Examiner into Inventions I, IV, V, VI, VII, VIII and IX, should have been included together, and should now be examined together, because the restriction requirement does not provide the factual support necessary to establish a *prima facie* case for restricting the claims into thirteen (13) different inventions.

The Restriction/Election requirement in the October 7, 2004 Office Action classified the independent claims of the above-captioned application in the following manner:

- 1) Group I, claims 1-43 and 92-108, drawn to a fixation device, classified in class 606, subclass 73;
- 2) Group II, claims 44-60, drawn to a fixation device, classified in class 606, subclass 104;

- 3) Group III, claims 61-74, drawn to a fixation device, classified in class 606, subclass 86;
- 4) Group IV, claims 75-91, drawn to a fixation device, classified in class 606, subclass 60;
- 5) Group V, claims 109-126, drawn to a fixation device, classified in class 606, subclass 61;
- 6) Group VI, claims 127-143, drawn to a fixation device, classified in class 606, subclass 72;
- 7) Group VII, claims 144-159, drawn to a fixation device, classified in class 606, subclass 59;
- 8) Group VIII, claims 160-174, drawn to a method, classified in class 623, subclass 16.11;
- 9) Group IX, claims 175-184, drawn to a method, classified in class 606, subclass 99;
- 10) Group X, claim 185, drawn to a method, classified in class 606, subclass 53;
- 11) Group XI, claim 186, drawn to a method, classified in class 128, subclass 898;
- 12) Group XII, claims 187-189, drawn to a method, classified in class 606, subclass 72; and
- 13) Group XIII, claim 190, drawn to a method, classified in class 606, subclass 61.

Applicant respectfully submits that some amount of restriction may be justified by the Office in this case, but Applicant

respectfully submits that an appropriate restriction requirement would group the claims into, at most, four (4) different inventions identified in Response A by Applicant, instead of the thirteen (13) different inventions identified above and contained in the October 7, 2004 Office Action. Accordingly, Applicant submits that the October 7, 2004 restriction is too narrow and improper for the following reasons.

According to the October 7, 2004 Office Action restriction of Inventions IV from I, and V from I, and VI from I, and VII from I is proper because the inventions are related as combination and subcombination. Inventions having such a relationship are distinct if it can be shown that (1) the combination does not require the particulars of the subcombination for patentability, **and** (2) that the subcombination has utility by itself or in another combination. MPEP § 806.05(c).

Further, the October 7, 2004 Office Action stated that restriction of Inventions VIII from I, and IX from I is proper because they are related as process and apparatus for its practice. Inventions having such a relationship are distinct if it can be shown either that (1) the process can be practiced by another **materially different** apparatus or by hand, or (2) the apparatus can be used to practice another **materially different** process. MPEP § 806.05(e).

Applicant respectfully submits that claims 1-43 and 75-184 as grouped by the Examiner into Inventions I, IV, V, VI, VII, VIII and IX should have been included together because the restriction does not provide factual support necessary to satisfy each of the above enumerated criteria. As demonstrated below, each of the combinations do in fact require the limitations of the subcombination, which the Office erroneously believes is missing from the combination. Further, the Office has not demonstrated or suggested utility for the subcombination other than as used in the combination in contravention with MPEP § 806.05(c).

Similar reasoning holds true with process and apparatus claims. Namely, the process cannot be practiced with a **materially** different apparatus as suggested by the October 7, 2004 Office Action because there are limitations in the process claims relating directly to a specific apparatus, which limitations are common to the independent claims in both Inventions. Therefore, Inventions I, IV, V, VI, VII, VIII and IX should have been included together for examination.

**Regarding Inventions IV and I**, the Office Action states they are related as combination and subcombination. According to the Office, restriction is proper because the combination (Invention IV - independent claim 75) does not require the particulars of the subcombination (Invention I - independent claims 1, 27, and 92) in that it does not need the internal sidewalls defining a female

tapered first through passage. However, independent claim 75 does in fact require internal sidewalls defining a female tapered first through passage. See claim 75, lines 4-6.

The Office has failed to establish that the combination does not require the particulars of the subcombination because all of the independent claims of Invention IV (independent claim 75) and Invention I (independent claims 1, 27, and 92) require internal sidewalls defining a female tapered first through passage. Further, the Office has not demonstrated or suggested utility for the subcombination other than as used in the combination in contravention with MPEP § 806.05(c). Both the combination and the subcombination are directed to fixation devices. Therefore, the Office has failed to establish that Inventions IV and I are distinct. Applicant therefore submits that claims 1-43 and 75-108 as grouped by the Office into Inventions I and IV should have been included together.

**Regarding Inventions V and I,** the Office Action states they are related as combination and subcombination. According to the Office, restriction is proper because the combination (Invention V - independent claim 109) does not require the particulars of the subcombination (Invention I - independent claims 1, 27, and 92) in that it does not need the fastening member having a male tapered external portion. However, independent claim 109 does in fact require attaching means, which is defined in the specification

pursuant to 35 U.S.C. § 112, sixth paragraph, having a male tapered external portion. See claim 109, lines 4-6.

The Office has failed to establish that the combination does not require the particulars of the subcombination because all of the independent claims of Invention V (independent claim 109) and Invention I (independent claims 1, 27, and 92) require a male tapered external portion. Further, the Office has not demonstrated or suggested utility for the subcombination other than as used in the combination in contravention with MPEP § 806.05(c). Both the combination and the subcombination are directed to fixation devices. Therefore, the Office has failed to establish that Inventions V and I are distinct. Applicant therefore submits that claims 1-43 and 92-126 as grouped by the Office into Inventions I and V should have been included together.

**Regarding Inventions VI and I**, the Office Action states they are related as combination and subcombination. According to the Office, restriction is proper because the combination (Invention VI - independent claim 127) does not require the particulars of the subcombination (Invention I - independent claims 1, 27, and 92) in that it does not need the fastening member having a male tapered external portion. However, independent claim 127 does in fact require attaching means, which is defined in the specification pursuant to 35 U.S.C. § 112, sixth paragraph, having a male external taper. See claim 127, lines 7-8.

The Office has failed to establish that the combination does not require the particulars of the subcombination because all of the independent claims of Invention VI (independent claim 127) and Invention I (independent claims 1, 27, and 92) require a male tapered external portion or a male external taper. Further, the Office has not demonstrated or suggested utility for the subcombination other than as used in the combination in contravention with MPEP § 806.05(c). Both the combination and the subcombination are directed to fixation devices. Therefore, the Office has failed to establish that Inventions VI and I are distinct. Applicant therefore submits that claims 1-43, 92-108 and 127-143 as grouped by the Office into Inventions I and VI should have been included together.

**Regarding Inventions VII and I,** the Office Action states they are related as combination and subcombination. According to the Office, restriction is proper because the combination (Invention VII - independent claim 144) does not require the particulars of the subcombination (Invention I - independent claims 1, 27, and 92) in that it does not need the connecting member having internal sidewalls defining a female tapered first through passage. However, independent claim 144 does in fact require connecting member having internal sidewalls defining a female tapered first through passage. See claim 144, lines 2-4.

The Office has failed to establish that the combination does not require the particulars of the subcombination because all of

the independent claims of Invention VII (independent claim 144) and Invention I (independent claims 1, 27, and 92) require a connecting member having internal sidewalls defining a female tapered first through passage. Further, the Office has not demonstrated or suggested utility for the subcombination other than as used in the combination in contravention with MPEP § 806.05(c). Both the combination and the subcombination are directed to fixation devices. Therefore, the Office has failed to establish that Inventions VII and I are distinct. Applicant therefore submits that claims 1-43, 92-108 and 144-159 as grouped by the Office into Inventions I and VII should have been included together.

Regarding Inventions VIII and I, the Office Action states they are related as process and apparatus for its practice. According to the Office, restriction is proper because the process (Invention VIII - independent claim 160) can be practiced with a **materially** different apparatus than the apparatus of Invention I (independent claims 1, 27, and 92). According to MPEP § 806.05(e): "The burden is on the examiner to provide reasonable examples that recite material differences." In the instant case, the Office has not recited any material differences between the claims in question. In fact, independent claim 160 does not require a materially different apparatus as Invention I as required by MPEP § 806.05(e) because the claims of Invention I and VIII contain similar limitations, such that any difference between them is not a

material difference, even though the scope of the claims are different.

Therefore, the Office has failed to establish that the process can be practiced with a materially different apparatus, and in fact has not even suggested or recited any type of material difference whatsoever. The independent claims of Invention VIII (independent claim 160) and Invention I (independent claims 1, 27, and 92) all require an apparatus that is not materially different from one another. Therefore, the Office has failed to establish that Inventions VIII and I are distinct. Applicant therefore submits that claims 1-43, 92-108 and 160-174 as grouped by the Office into Inventions I and VIII should have been included together.

**Regarding Inventions IX and I**, the Office Action states they are related as process and apparatus for its practice. According to the Office, restriction is proper because the process (Invention IX - independent claim 175) can be practiced with a **materially** different apparatus than the apparatus of Invention I (independent claims 1, 27, and 92). According to MPEP § 806.05(e): "The burden is on the examiner to provide reasonable examples that recite material differences." In the instant case, the Office has not recited any material differences between the claims in question. In fact, independent claim 175 does not require a materially different apparatus as Invention I as required by MPEP § 806.05(e) because the claims of Invention I and IX contain similar

limitations, such that any difference between them is not a material difference, even though the scope of the claims are different.

Therefore, the Office has failed to establish that the process can be practiced with a materially different apparatus, and in fact has not even suggested or recited any type of material difference whatsoever. The independent claims of Invention IX (independent claim 175) and Invention I (independent claims 1, 27, and 92) all require an apparatus that is not materially different from one another. Therefore, the Office has failed to establish Inventions IX and I are distinct. Applicant therefore submits that claims 1-43, 92-108 and 175-184 as grouped by the Office into Inventions I and IX should have been included together.

Applicant respectfully submits that restriction of the claims in the instant case may be appropriate as modified in Applicant's Response A and this Addendum to Response A, such that claims 1-43 and 75-184 should all be examined together as a single invention.

#### CONCLUSION

In view of the foregoing, Applicant believes that claims 1-43 and 75-184 should all be examined together as a single invention, each claim having a different scope. Applicant further believes that claims 1-43 and 75-184 are all allowable as originally filed, and a finding of the same is respectfully requested. If any impediment to the allowance of these claims remains after entry of

this Amendment, and such impediment could be alleviated during a telephone interview, the Examiner is invited to initiate the same.

The Commissioner is hereby authorized to charge any additional fee or to credit any overpayment in connection with this Amendment to Deposit Account No. 50-0836.

DATED this 22 day of April, 2005.

Respectfully submitted,



Karl R. Cannon  
Attorney Registration No. 36,468  
Attorney for Applicant

Clayton, Howarth & Cannon, P.C.  
P.O. Box 1909  
Sandy, UT 84091  
Telephone: (801) 255-5335  
Facsimile: (801) 255-5338

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